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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/513,116	02/25/2000	Eric Mao		6642

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Eric Mao  
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EXAMINER

SHIPSIDES, GEOFFREY P

ART UNIT	PAPER NUMBER
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1732

DATE MAILED: 02/12/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/513,116

Applicant(s)

MAO, ERIC

Examiner

Geoffrey P. Shippides

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 December 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All   b) ☐ Some \*   c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Specification***

1. 35 U.S.C. 112, first paragraph, requires the specification to be written in "full, clear, concise, and exact terms." The specification is replete with terms which are not clear, concise and exact. The specification should be revised carefully in order to comply with 35 U.S.C. 112, first paragraph. Examples of some unclear, inexact or verbose terms used in the specification are: on page 2, line 3, the phrase "wherein defect product formed can be controlled" is unclear; on page 4, the description of the figures should note that the trademark shown in the drawings is a registered trademark of the Nike Corporation; on page 5, line 13 the phrase "is undergone" is incorrect grammar and should be replaced with something similar to --undergoes--; on page 7, line 8, the phrase "will not expose beyond the blank material" is unclear. This is not a complete listing.

2. A substitute specification in proper idiomatic English and in compliance with 37 CFR 1.52(a) and (b) is required. The substitute specification filed must be accompanied by a statement that it contains no new matter. Further, the specification should also note that the trademark depicted on the figures is a registered trademark of the Nike Corporation.

3. An examination of this application reveals that applicant is unfamiliar with patent prosecution procedure. While an inventor may prosecute the application, lack of skill in this field usually acts as a liability in affording the maximum protection for the invention disclosed. Applicant is advised to secure the services of a registered patent attorney or

agent to prosecute the application, since the value of a patent is largely dependent upon skilled preparation and prosecution. The Office cannot aid in selecting an attorney or agent.

4. Applicant is advised of the availability of the publication "Attorneys and Agents Registered to Practice Before the U.S. Patent and Trademark Office." This publication is for sale by the Superintendent of Documents, U.S. Government Printing Office, Washington, D.C. 20402.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Lines 6-8 of claim 6 are unclear as they recite, "mixing injection molding material with a material similar or alike the material of the ribbon stripe so that these materials can form as one unit when melted", this is however unclear as it is unclear if these two material form as one unit when melted or if this mixture of materials and the ribbon stripe form as one unit when melted in the injection molding process of the primary blank material. Further the use of the language "similar or alike" is further unclear as it is unclear which material would constitute a similar or alike material. These lines are further unclear as it is unclear where this material is being injection molded.

Lines 9-13 of claim 6 are also unclear as it recites "high pressure injection molding the ribbon stripe to combine with the primary blank plastic material and a protruded trade mark pattern being formed on the primary blank plastic material, and injection molding the primary blank plastic material into a mold combination end of the ribbon stripe". This seems to teach the formation of the ribbon stripe by injection molding, which is not supported by the original specification. It seems that the language of lines 9-13 should be replaced by language that teaches the injection molding of mixture (formed in lines 6-8) into the mold holding the combination end of the ribbon stripe in order to form a primary blank plastic material that includes a protruded trademark pattern.

Lines 14-19 of claim 6 are also unclear. It appears that these lines teach the placement of the primary blank plastic material into a second mold where a second injection molding material is injection molded over the primary blank plastic material where only the protruded trademark pattern of the primary blank plastic material is not covered by the second injection molding material. It is noted that lines 14-19 do not clearly recite this. The phrase "processing to a second injection molding" (on line 17) is unclear as it does not teach the injection molding of the second material.

Claim 6 further recites the limitation "the combination end" in line 5. There is insufficient antecedent basis for this limitation in the claim. It is recommended that the phrase --of the ribbon stripe-- be inserted after the word "end" on line 5 of claim 6.

Claim 6 further recites the limitation "the primary blank plastic material" in line 10. There is insufficient antecedent basis for this limitation in the claim.

It is further unclear

Claim 6 is generally narrative and indefinite, failing to conform with current U.S. practice. It appears to be a literal translation into English from a foreign document and is replete with grammatical and idiomatic errors.

Corrective action is necessary.

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claim 6 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Line 9 of claim 6 recites, "high pressure injection molding the ribbon stripe", this however is unclear, as the instant specification does not teach how the ribbon stripe is produced. The applicant teaches a ribbon texture that includes gaps in the instant specification and it is unclear how such a ribbon strip could be produced through injection molding, and thus the forming of such a ribbon stripe through injection molding is not enabled.

### ***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over admitted prior art (Admission) in view of U.S. Patent No. 4,163,819 (Yung et al.) and U.S. Patent No. 5,964,009 (Hoepfl et al.).

Admission teaches that it is known to provide a soft ribbon stripe with a plastic mark (Page 1, lines 13-14 of the instant specification). Admission teaches it is conventionally known to place a rigid article within a recess of a mold followed by injecting material into the mold to provide the surface of the molded article with a specific mark or logo (Page 1, lines 9-12 of the instant specification).

With regard to claim 6, Admission does not teach the thermal pressing of a combination end of the ribbon stripe to cure a texture of the ribbon stripe. Yung et al. teaches that heat and pressure will cause a non-woven fabric to become stiff (Column 2, lines 7-26). It would have been obvious to one having ordinary skill in the art at the time of invention to use heat and pressure (thermally press) the part of the soft ribbon stripe (as taught by Admission) in order to make the ribbon strip stiff (or rigid) as taught by Yung et al. in order to make the soft ribbon stripe suitable for conventional injection molding process for forming a specific mark or logo on to the soft ribbon stripe.

Admission, further, does not teach a two part molding operation where a first material forms an inner part with only a protruding trademark exposed in the final product, and a second material that is injection molded over the first material. Hoepfl et al. teaches such a process for forming tool handles (figures, Column 2, lines 47-65). It would have been obvious to one having ordinary skill in the art at the time of invention to use the process of Hoepfl of forming a decorative injection molded part on to the

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ribbon stripe as taught by Admission in order to form a more resilient decoration (trademark).

Admission does not teach a process of mixing injection molding material with material similar or alike the material of the ribbon stripe. It is, however, notoriously well known in the art of injection molding to use compatible materials in composite injection molding process in order to form a stronger bond between the preform and the injection molded material. It would have been obvious to one having ordinary skill in the art at the time of invention to mix compatible (similar) material into the first injection molded material in order to form a better bond between the ribbon stripe and the injection molded material as is well known in the art.

### ***Response to Arguments***

**11.** Applicant's arguments with respect to claim 5 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Geoffrey P. Shippides whose telephone number is 703-306-0311. The examiner can normally be reached on Monday - Friday 9 AM till 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard D Crispino can be reached on 703-308-3853. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.



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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Geoffrey P. Shipsides/gps  
February 8, 2003

A handwritten signature in black ink, appearing to read 'Mark Eashoo', with a stylized flourish at the end.

MARK EASHOO, PH.D  
PRIMARY EXAMINER

10/feb/03